



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,384	08/15/2001	James E. King	5681-04200	9196

7590 04/18/2007
B. Noel Kivlin
Conley, Rose, & Tayon, P.C.
P.O. Box 398
Austin, TX 78767

EXAMINER

KHOSHNOODI, NADIA

ART UNIT	PAPER NUMBER
----------	--------------

2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/930,384

Applicant(s)

KING ET AL.

Examiner

Nadia Khoshnoodi

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-15, 17-23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15, 17-23 and 25-35 is/are rejected.
- 7) ☒ Claim(s) 12, 16, 24, 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Appeal Brief

Claims 1-36 are pending in the current application.

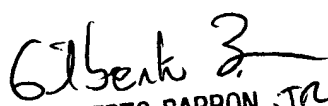
In view of the Appeal Brief filed on 12/26/2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Response to Amendments filed with the Appeal Brief

With regard to the amendments filed 6/15/2006 made to traverse the 35 USC 101 rejections applied to claims 21-25, 27, and 28, Examiner withdraws the previously made 35 USC 101 rejections since Applicants have amended to ensure that the program is in fact on a storage medium, which as defined by page 35 of the specification, is tied to an article of manufacture.

Allowable Subject Matter

Claims 12, 16, 24, and 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior arts of record taken singly, or in combination with one another, fail to disclose wherein the network identifier on the smart card is a MAC address.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1, 5-8, 13-14, 29-31:

It has been held that the recitation that an element is “operable to” or “configured to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. It is noted that Applicants intended to use these terms for a broader scope, however Examiner would like some clarification on whether or not this is the case. If Applicants did not intend to claim that the elements are only “operable” or “configured” to perform some type of function, that language may be removed from the claims so that the limitations are given full weight. As per claims 1, 7, 13, 21, 29-31, and 35:

The phrase “key-key encryption” is mentioned in each of the claims listed, where although phrases in the claims are taken in light of the specification, the specification cannot be read into the claims. Furthermore, Examiner could not locate an exact definition for this term, only references to other synonyms on page 20 and therefore the scope of this term is not readily ascertained. In order to further treat these claims on their merits, the term “key-key encryption” is interpreted as any type of asymmetric key encryption, i.e. a public/private key pair.

****Claims not specifically addressed are rejected by virtue of their dependency.**

Claim Rejections - 35 USC § 102

I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

II. Claims 1-6, 9-11, and 31-34 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Dancs et al., US Patent No. 6,108,789.

As per claims 1 and 31:

Dancs et al. teach a portable storage device comprising: storage, the storage configured to store a network identity for the processing unit and at least one encryption key (col. 4, lines 3-8 and col. 6, line 65 – col. 7, line 5), and an access controller, the access controller being operable to control access to the storage by implementing key-key encryption (col. 8, lines 29-50; col. 9, lines 3-32; and col. 16, lines 65-67).

As per claims 2 and 32:

Dancs et al. teach the portable storage device of claims 1 and 31. Furthermore, Dancs teach the portable storage device comprising at least one secure storage portion accessible only under the control of the access controller (col. 6, line 65 – col. 7, line 5 and col. 18, lines 1-20).

As per claims 3 and 33:

Dancs et al. substantially teach the portable storage device of claim 2 and 32. Furthermore, Dancs et al. teach the portable storage device wherein said at least one encryption key is held in said secure storage portion (col. 6, line 65 – col. 7, line 5).

As per claims 4 and 34:

Dancs et al. substantially teach the portable storage device of claims 2 and 32. Furthermore, Dancs et al. teach the portable storage device wherein at least one network security encryption key is held in said secure storage portion (col. 6, line 65 – col. 7, line 5).

As per claim 5:

Dancs et al. substantially teach the portable storage device of claim 2. Furthermore, Dancs et al. teach wherein a file is configured in said secure storage portion (col. 9, lines 3-16).
As per claim 6:

Dancs et al. substantially teach the portable storage device of claim 2. Furthermore, Dancs et al. teach wherein one or more files containing information are configured in respective secure storage portions (col. 9, lines 3-16 and col. 17, lines 40-45).
As per claim 9:

Dancs et al. teach the portable storage device of claim 2. Furthermore, Dancs et al. teach wherein the storage in the portable storage device comprises random access memory, the secure storage comprising a part of the random access memory (col. 2, lines 22-32).

As per claim 10:

Dancs et al. teach the portable storage device of claim 1. Furthermore, Dancs et al. teach wherein the access controller is a programmed microcontroller (col. 9, lines 4-16).

As per claim 11:

Dancs et al. substantially teach the portable storage device of claim 1. Furthermore, Dancs et al. teach wherein the portable storage device is a smart card (col. 2, lines 22-32).

Claim Rejections - 35 USC § 103

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

IV. Claims 7-8, 13-15, 17-23, 25-30, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dancs et al., US Patent No. 6,108,789 and further in view of Rubin et al., US Patent No. 5,809,140.

As per claim 7 and 35:

Dancs et al. substantially teach the portable storage device of claims 2 and 31.

Furthermore, Dancs et al. teach wherein the access controller is operable to perform key-key verification of a request encrypted by a request key supplied from the processing unit (col. 14, lines 16-25). Furthermore, Dancs et al. teach wherein the ISP must be authenticated via the NC client before allowing the ISP to write account information onto the smart card (col. 16, lines 48-66).

Not explicitly disclosed is where, in response to the request key verifying correctly, to return to the processing unit an access key derived from said at least one encryption key to permit access to the secure storage portion. However, Rubin teaches establishment of a session key for smart cards for communications, where only a process on a given host has the ability to access, i.e. make requests to write/read information, the smart card (col. 6, lines 39-53).

Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Dancs et al. for the smart card to establish a session key with a host in order to allow only certain hosts access to the smart card and to use that session key for communications between the smart card and the host. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Rubin suggests that creating a session key for communications each time a communication attempt is made ensures that a secret key is not

Art Unit: 2137

stored long-term to prevent it from being compromised and still yields a secure data transfer in col. 3, lines 7-16.

As per claim 8:

Dancs et al. and Rubin et al. substantially teach the portable storage device of claim 7. Furthermore, Rubin et al. teach wherein the access controller is subsequently operable to respond to a command from the processing unit that is encrypted using the access key to access the secure storage portion (col. 6, lines 39-53).

As per claims 13, 21, 29, and 30:

Dancs et al. substantially teach a processing unit, a control program for a processing unit, a microcontroller, and a server computer comprising: a device reader for reading the portable storage device (col. 4, lines 3-5), the portable storage device comprising storage containing an access controller, the storage holding a network identity for the processing unit and at least one encryption key (col. 4, lines 3-8 and col. 6, line 65 – col. 7, line 5), and the access controller being operable to control access to the storage by implementing key-key encryption (col. 8, lines 29-50; col. 9, lines 3-32; and col. 16, lines 65-67) and the processing unit being operable to access a secure portion of the storage of the portable storage device by supplying a key-encrypted request to the access controller (col. 14, lines 16-25). Furthermore, Dancs et al. teach wherein the ISP must be authenticated via the NC client before allowing the ISP to write account information onto the smart card (col. 16, lines 48-66).

Not explicitly disclosed is where, in response to receipt of an access key from the access controller, being operable to send an encrypted command to access the content of the storage of the portable storage device. However, Rubin teaches establishment of a session key for smart

Art Unit: 2137

cards for communications, where only a process on a given host has the ability to access, i.e. make requests to write/read information, the smart card (col. 6, lines 39-53). Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Dancs et al. for the smart card to establish a session key with a host in order to allow only certain hosts access to the smart card and to use that session key for communications between the smart card and the host. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Rubin suggests that creating a session key for communications each time a communication attempt is made ensures that a secret key is not stored long-term to prevent it from being compromised and still yields a secure data transfer in col. 3, lines 7-16.

As per claims 14 and 22:

Dancs et al. and Rubin et al. substantially teach claims 13 and 21. Furthermore, Rubin et al. teach wherein, in response to the return of an access key, the processing unit is operable to use the access key to encrypt a command for access to a secure storage in the portable storage device (col. 6, lines 39-53).

As per claims 15 and 23:

Dancs et al. and Rubin et al. substantially teach claims 13 and 21. Furthermore, Dancs et al. teach wherein the wherein the access controller is a microcontroller (col. 9, lines 4-16) portable storage device is a smart card and the device reader is a smart card reader (col. 2, lines 6-7).

As per claims 17, 25, and 27:

Dancs et al. and Rubin et al. substantially teach claims 13 and 21. Furthermore, Dancs et al. teach a service processor, the service processor being programmed to control reading of the portable storage device (col. 14, lines 16-25).

As per claims 18 and 28:

Dancs et al. and Rubin et al. substantially teach claims 17 and 27. Furthermore, Dancs et al. teach wherein the wherein the access controller is a microcontroller (col. 9, lines 4-16).

As per claims 19 and 20:

Furthermore, Dancs et al. teach wherein the wherein the access controller is a microcontroller (col. 9, lines 4-16) substantially teach claim 13. Furthermore, Dancs et al. teach wherein the processing unit is a computer server or a rack mountable computer server (col. 16, lines 36-64).

As per claim 26:

Dancs et al. and Rubin et al. substantially teach the control program of claim 21. Furthermore, Dancs et al. teach the control program on a carrier medium (col. 2, lines 1-21).

**References Cited, Not Used*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US Patent No. 6,654,797
2. US Patent No. 6,260,111

The above references have been cited because they are relevant due to the manner in which the invention has been claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadia Khoshnoodi whose telephone number is (571) 272-3825. The examiner can normally be reached on M-F: 8:00-4:30.

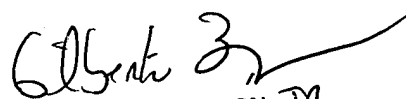
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nadia Khoshnoodi
Examiner
Art Unit 2137
4/11/2007

NK



GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100